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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,414

12/16/2005

Masao Yamada

1503.73148

1680

24978

7590

08/18/2008

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

08/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,414	Applicant(s) YAMADA, MASAO	
	Examiner Mark Halpern	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 6-48 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/2/05, 8/30/06, 6/17/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1) Applicant's election without traverse of invention I, drawn on claims 1-5, 49-51, in the reply filed on 7/21/2008 is acknowledged.

Claims 6-48, 52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected election, there being no allowable generic or linking claim.

Information Disclosure Statement

2) The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

All prior art references recited in the Specification (as, for example, recited on Pages 2-4) are to be listed on form PTO-1449 and copies of foreign references are to be provided for review.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3) Claims 1-5, 49-51, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1 phrase “no waste liquid may be caused even when compressing the disintegrated fibers” is not clear.

Claim 1 phrase “even when compressing” is conditional which renders the claim indefinite.

Claim 2 phrase “disintegrates the waste paper at a yield of 100 percent” is not clear.

Claim 3 phrase “a predetermined additive” is vague and not clear.

Claim 3 phrase “a specific characteristic” is vague and not clear.

Claim 5 phrase “colors the fibers in a predetermined color” is vague and not clear.

Claim 49 phrase “culture soil” is not clear.

Claim 51 phrase “culture soil” is not clear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 1-5, 49, 51, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura (JP 11-293578).

Claims 1: Kimura discloses a system for disintegrating a waste paper stock in a dry condition by supplying a water mist content of 8-12% of water (Abstract, entire document and figure). It would have been obvious to one skilled in the art at the time the invention was made that the small amount of water mist used is an amount of water within a range such that a liquid waste would not be produced even when the disintegrated fibers are compressed.

Claims 2, 4, 5: the amount of water to be added is a matter to be appropriate optimized during the system operation. Addition of an adhesive agent, filler and coloring of a fiber material are additions of components regularly used for manufacturing of paper articles.

Claim 3: Kimura discloses additive such as a polyisocyanate compound added to form a substance having certain properties

Claims 49, 51: it would have been obvious to utilize vessels of any shape and structure. Product formed to be used as culture soil or as fertilizer does not structurally

differentiate the present invention over the cited prior art.

5) Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Nishimura (JP 7-82686). Kimura is applied as above for claim 1, Kimura fails to disclose adding a fire retardant to waste paper pulp fibers to serve as incombustible material. Nishimura discloses adding a fire retardant to waste paper pulp fibers to serve as incombustible material (Abstract). It would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Kimura and Nishimura because such a combination would expand the applicability of the Kimura product as a flame resistant product.

Conclusion

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Halpern/
Primary Examiner
Art Unit 1791

Search Notes

Application No.

10/537,414

Examiner

Mark Halpern

Applicant(s)

YAMADA, MASAO

Art Unit

1791

SEARCHED

Class	Subclass	Date	Examiner
162	261,4, 8,55	8/14/2008	MH
241	46.17		
	259.1		
	261.3		
	28,29		

INTERFERENCE SEARCHED

Class	Subclass	Date	Examiner

**SEARCH NOTES
(INCLUDING SEARCH STRATEGY)**

	DATE	EXMR
East Search (history attached)	8/14/2008	MH
Inventor search conducted	8/14/2008	MH